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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,050	10/07/2003	Ralph O. Doughty	IVCC:1001	6731
34725	7590	07/16/2010	EXAMINER	
CHALKER FLORES, LLP			POLTORAK, PIOTR	
2711 LBJ FRWY				
Suite 1036			ART UNIT	PAPER NUMBER
DALLAS, TX 75234			2434	
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			07/16/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/680,050	Applicant(s) DOUGHTY ET AL.	
	Examiner PETER POLTORAK	Art Unit 2434	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-37,39-41,43-52,54-56,58-63,65 and 67-92 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-37, 39-41, 43-52, 54-56, 58-63, 65 and 67-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) ☐ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413) |
| 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) ☒ Information Disclosure Statement(s) (PTO/SB/08) | 5) ☐ Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/2/10</u> . | 6) ☐ Other: _____ |

DETAILED ACTION

1. Applicant's communication received on 5/10/10 has been entered.
2. The IDS received on 4/2/10 has been entered and the references cited within carefully considered.

Response to Amendment/Arguments

Applicant arguments have been carefully considered.

3. In light of applicant's amendment the previously cited objections are withdrawn.
4. In regard to the 35 U.S.C. 112 first paragraph rejection, applicant argues the written description by pointing to the paragraph 8-10, 39, 41 and 51 of the specification.

It appears that either applicant did not understand the issue raised by the examiner or the examiner did not understand applicant's clarification of the issue (or both).

The examiner appreciated that the specification discusses benefits of the invention as well offers various embodiments. However, the issue that was raised by the examiner essentially related to claim speculative connection of different embodiments. Note that the specification does not offer any signal embodiment supporting the limitations present in all independent claims which (now) require generating a magnetic field comprising a time-varying magnetic signal via the one or more induction coils and the magnetic stripe that is received by a magnetic stripe reader "in close proximity to the magnetic field generator without swiping the magnetic stripe through the magnetic stripe reader or inserting the magnetic stripe into the magnetic stripe reader or using an adapter to interface with the magnetic

stripe reader". Note that capability of creating signals using either induction coil or otherwise was not questioned in the rejection. Neither the capability of the apparatus to sending a signal without swiping/inserting the magnetic card into a reader. In order to read magnetic signal generated via a magnetic stripe and induction coils underneath a length of the magnetic stripe, the apparatus comprising the magnetic stripe and induction coils must be inserted/swiped into magnetic stripe readers. Another option is to send signal wirelessly, from an apparatus to a reader, but the magnetic stripe reader and coils underneath are not used in this embodiment. The examiner did not find clarification enabling understanding the functionality of the claimed coils and magnetic stripe, which prompted the 35 U.S.C. 112 first paragraph, new matter issue. However, applicant's response and the newly introduced limitation (without ... using an adapter to interface with the magnetic stripe reader") raises an additional, enablement issue. Based on the prior art the examiner cannot foresee how the invention can be accomplished as claimed and in order to actually practice the invention a person skilled in the relevant art would have to engage in an undue amount of experimentation. As a result, in addition to the previously cited 35 U.S.C. 112 first paragraph rejection, the enablement rejection is included in this Office Action in order to require the applicant to clarify the issue.

5. Please note, that upon applicant's response, hopefully clarifying the issue, an omitted essential limitation rejection can be introduced.
6. Claims 1, 3, 5-37, 39-41, 43-52, 54-56, 58-63, 65 and 67-92 have been examined.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1, 3, 5, 9, 11, 14-37, 39-41, 43-52, 54-55, 58-63, 65, 67, 71, 73 and 76-83 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the limitations requiring receiving by a magnetic stripe reader in close proximity to the magnetic field generator without swiping the magnetic stripe through the magnetic stripe reader or inserting the magnetic stripe into the magnetic stripe reader or using an adapter to interface with the magnetic stripe reader" a generated via the one or more induction coils and the magnetic stripe time-varying magnetic signal, is not found in the originally filed specification.
9. Claims 1, 3, 5, 9, 11, 14-37, 39-41, 43-52, 54-55, 58-63, 65, 67, 71, 73 and 76-83 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not

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described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, it is not clear how a generated time-varying magnetic signal via the one or more induction coils and the magnetic stripe could be received by a magnetic stripe reader “in close proximity to the magnetic field generator **without** swiping the magnetic stripe through the magnetic stripe reader or inserting the magnetic stripe into the magnetic stripe reader or using an adapter to interface with the magnetic stripe reader”.

Appropriate correction is required.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571) 272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Peter Poltorak/

Examiner, Art Unit 2434

/Kambiz Zand/

Supervisory Patent Examiner, Art Unit 2434